

REMARKS

I. Status of the Claims

Claims 11 - 19 and 21 -100 are now pending in this application. Claims 43-99 have been withdrawn from consideration. Claims 11-42 and 100 have been examined. Claim 11 has been amended to incorporate the subject matter of claim 20. Claim 20 has been canceled.

II. Rejection under 35 U.S.C. § 112, second paragraph

Claim 100 is rejected under 35 U.S.C. § 112, as allegedly being indefinite. *Final Office Action* at p. 2. Applicants respectfully traverse this rejection.

In the previous Reply, Applicants had amended claim 100 to delete "of the formula," which the Examiner believed rendered claim 100 unclear. *Id.* at p. 3. This amendment was not addressed in the Advisory Action. Applicants believe that this amendment overcame the rejection and respectfully requests withdrawal of this rejection.

III. Rejections under 35 U.S.C. § 102

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. *See* M.P.E.P. § 2131.

A. Yarovenko

1. Claim 100 is rejected under 35 U.S.C. § 102(b) as being anticipated by Yarovenko et al. (DN 73:34993, CAPLUS, abstract of Zh. Org. Khim. (1970), 6(5), 947-9). *11/11/02 Office Action* at p. 3.

In the previous Reply, Applicants had amended claim 100 to replace "imino(phenylamino)methane-sulphinic acid" with (carboxymethylamino)iminomethanesulphinic acid. This amendment was not addressed in the Advisory Action. Applicants believe that this amendment overcame the rejection and respectfully requests withdrawal of this rejection.

2. Claims 11, 12, 16-19, and 39-41 are also rejected under 35 U.S.C. § 102(b) as being anticipated by Yarovenko et al. *11/11/02 Office Action* at pp. 3-4. In the Final Office Action, the Examiner sustained the rejection because "composition is not relied upon the intended use." *Office Action* at p. 2. Applicants respectfully traverse this rejection.

Applicants have previously presented arguments to support their position that claim 11 is patentable over Yaravenko. Although Applicants still maintain their position for the record, in the interest of advancing prosecution, Applicants have amended claim 11 to incorporate the limitations of claim 20. Claim 20 recites a composition further comprising at least one additive chosen from reducing agents other than said at least one reducing agent, certain surface-active agents, certain treating agents, fatty alcohols, lanolin derivatives, active ingredients, agents for combating hair loss, antidandruff agents, thickeners, suspending agents, sequestering agents, opacifying agents, colorants, sunscreen agents, fragrances, and preservatives.

Because claim 20 was not the subject of this rejection, and because Yarovenko neither discloses nor teaches reducing compositions further comprising the at least one additive as claimed, Applicants respectfully request withdrawal of this rejection.

B. Shibanov

Claims 11-19 and 39-41 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shibanov et al. (DN 70:87599, CALUS, abstract of SU 229521).

11/11/02 Office Action at pp. 4-5. As with Yarovenko above, Shibanov is cited to show the disclosure of a single compound, which the Examiner believes is sufficient to anticipate the claimed compositions. *Id.* at p. 2. Applicants respectfully traverse this rejection.

Applicants have previously presented arguments to support their position that claim 11 is patentable over Shibanov. Although Applicants still maintain their position for the record, in the interest of advancing prosecution, Applicants have amended claim 11 to incorporate the limitations of claim 20, as discussed above. Because claim 20 was not the subject of this rejection, and because Shibanov neither discloses nor teaches reducing compositions further comprising the at least one additive as claimed, Applicants respectfully request withdrawal of this rejection.

IV. Rejection under 35 U.S.C. § 103

Claims 11-12, 16-42, and 100 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Amon (GB 1 201 601). *11/11/02 Office Action* at p. 6. According to the Examiner, Amon “teaches a reducing composition for hair waving or straightening containing aminoiminomethanesulfinic acid or a water-soluble salt thereof.” *Id.*

Applicants continue to traverse the rejection for reasons of record and the additional reasons set forth below.

As the Examiner knows, to establish a *prima facie* case of obviousness, an Examiner must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference. See M.P.E.P. § 2143.01. Additionally, the prior art must provide a reasonable expectation of success. M.P.E.P. § 2143.02.

In the previous Reply, Applicants had argued that Amon fails to teach or suggest any other compound besides formamidinesulphinic acid as a reducing agent. Amon lists several benefits of using formamidinesulphinic acid and does not teach or suggest that the presently claimed derivatives can achieve these benefits. Moreover, Amon does not provide a reasonable expectation of success that using the presently claimed derivatives of formamidinesulphinic acid will achieve such benefits.

Applicants note that the only remarks in the Advisory Action were directed to the alleged intended use limitations. The Examiner failed to comment on Applicants' arguments against the *prima facie* case. Applicants respectfully submit that:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

M.P.E.P. § 707.07(f).

Accordingly, Applicants respectfully request withdrawal of this rejection.

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V. Conclusion

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, she is invited to call the undersigned at (617) 452-1621.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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